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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
08/856,376	05/14/1997	MARK CHEE	16528X-02501	2915

33494 7590 06/26/2003

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EXAMINER

MARSCHER, ARDIN H

ART UNIT	PAPER NUMBER
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1631

DATE MAILED: 06/26/2003

29

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

08/856,376

Applicant(s)

Chee et al.

Examiner

Ardin Marschel

Art Unit

1631

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 6/28/02 and 10/4/02
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1, 3-10, and 15-33 is/are pending in the application.
- ~~Claim(s) 2 and 11-14 have been canceled.~~ ~~is/are withdrawn from consideration~~
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1, 3-10, and 15-33 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claims _____ are subject to restriction and/or election requirement

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a) ☐ All b) ☐ Some* c) ☐ None of:

- ☐ Certified copies of the priority documents have been received.
- ☐ Certified copies of the priority documents have been received in Application No. _____.
- ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

*See the attached detailed Office action for a list of the certified copies not received.

- 14) ☒ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

a) ☐ The translation of the foreign language provisional application has been received.

- 15) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- ☐ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s). _____
- ☐ Interview Summary (PTO-413) Paper No(s). _____
- ☐ Notice of Informal Patent Application (PTO-152)
- ☐ Other:

Applicants' arguments, filed 6/28/02 and 10/4/02, have been fully considered but they are not deemed to be persuasive. Rejections and/or objections not reiterated from previous office actions are hereby withdrawn. Upon reconsideration, the following rejections and/or objections are either reiterated or newly applied. They constitute the complete set presently being applied to the instant application.

SEQUENCE RULE NON-COMPLIANCE

This application contains sequence disclosures that are encompassed by the definitions for nucleotide and/or amino acid sequences set forth in 37 CFR § 1.821(a)(1) and (a)(2). However, this application fails to comply with the requirements of 37 CFR § 1.821 through 1.825 because the computer readable form sequence listing does not contain the same number of sequences as the paper copy, filed 12/11/01. The paper copy, filed 12/11/01, contains 30 sequences, whereas, in contrast the computer readable form sequence listing, filed as a copy on 11/4/02, contains 77 sequences. Applicants are therefore required to submit either a new computer readable form sequence listing or paper copy as appropriate and new statements under 37 CFR § 1.821(f) and (g) corresponding to the new listing. Failure to respond to this requirement may result in abandonment of the instant application or a notice of a failure to fully respond to this Office action.

LACK OF UTILITY

The pending claims have been reviewed in light of the Utility Examination Guidelines and Guidelines for Examination of Patent Applications under 35 U.S.C. 112, first paragraph, "Written Description" Requirement, Federal Register, Vol. 66, No. 4, pages 1092-1111, Friday, January 5, 2001.

The examiner is using the following definitions in evaluating the claims for utility.

"Specific" - A utility that is *specific* to the subject matter claimed. This contrasts with a *general* utility that would be applicable to the broad class of the invention.

"Substantial" - A utility that defines a "real world" use. Utilities that require or constitute carrying out further research to identify or reasonably confirm a "real world" context of use are not substantial utilities.

"Credible" - Credibility is assessed from the perspective of one of ordinary skill in the art in view of the disclosure and any other evidence of record that is probative of the applicant's assertions. That is, the assertion is an inherently unbelievable undertaking or involves implausible scientific principles.

"Well-established" - a specific, substantial, and credible utility which is well known, immediately apparent, or implied by the specification's disclosure of the properties of a material, alone or taken with the knowledge of one skilled in the art.

35 U.S.C. § 101 reads as follows:

"Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter or any new and useful improvement thereof, may obtain a patent therefore, subject to the conditions and requirements of this title".

Claims 1, 3-10, and 15-33 are rejected under 35 U.S.C. § 101 because the claimed invention lacks patentable utility due to its not being supported by a specific, substantial, and credible utility or, in the alternative, a well-established utility.

The claimed subject matter is not supported by a specific, substantial, and credible utility because the disclosed uses are generally applicable to broad classes of this subject matter and have not been established as having specific and substantial utility. In addition, further characterization of the claimed subject matter would be required to identify or reasonably confirm a "real world" use. The examiner does not find an adequate nexus between the evidence of record and the asserted properties of the claimed subject matter. Due to a lack of either an art recognized or alleged well established utility, the instant invention, as claimed, has been rejected due to also lacking the then required combination of a specific, substantial, and credible utility. Although it may be credible that the polymorphic sites as claimed may correlate with a disease or

other useful condition, the lack of a specific and substantial utility, as explained more fully below, sufficiently supports this rejection.

It is acknowledged that applicants have stated in the specification on page 1, lines 16-18, that human mitochondrial DNA is information-rich. It is also acknowledged that a long list of polymorphic sites in mitochondrial DNA have been set forth in the instant application. Applicants describe the possibility of defining groups of individuals to find characteristic patterns on page 10, lines 1-20, but do not therein supply even one such specific or substantial pattern. Forensics is similarly discussed starting on page 13, but again without any specific or substantial pattern defined. The lack of specific or substantial patterns as correlated with phenotypic traits is also an issue in the section starting on page 14. The mapping of certain disease traits to mitochondrial genes is discussed on page 14, lines 21-33, again without linking any of these with the instantly claimed polymorphic sites. An array study is discussed regarding polymorphic analysis results on page 26, lines 24-37, to identify Caucasian from African samples. Clustered differences were discussed but without stating what these differences are. Thus, even this example lacks specificity as to what polymorphic sites may be utilized for identification. It is apparent that further research is required in order to link

polymorphic site data/patterns with even one disease, or identification method of use, given the instantly listed polymorphic sites. The need for further research in order to define a utility supports this rejection based on a lack of either a well established utility for the instant polymorphic sites, or, alternatively, a specific and substantial utility. Applicants are suggested to explicitly identify a specific, substantial, and credible utility for the claimed invention and establish a probative relation between any evidence of record and the originally disclosed properties of the claimed invention.

LACK OF ENABLEMENT

Claims 1, 3-10, and 15-33 are also rejected under 35 U.S.C. § 112, first paragraph. Specifically, since the claimed invention is not supported by a specific, substantial, and credible utility or a well-established utility for the reasons set forth above, one skilled in the art would not know how to use the claimed invention.

No claim is allowed.

Papers related to this application may be submitted to Technical Center 1600 by facsimile transmission. Papers should be faxed to Technical Center 1600 via the PTO Fax Center located in Crystal Mall 1. The faxing of such papers must conform with the notices published in the Official Gazette, 1096 OG 30 (November 15, 1988), 1156 OG 61 (November 16, 1993), and 1157 OG 94 (December 28, 1993) (See 37 CFR § 1.6(d)). The CM1 Fax Center number is either (703)308-4242 or (703)305-3014.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to

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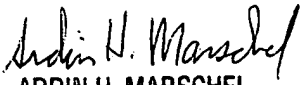
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Ardin Marschel, Ph.D., whose telephone number is (703)308-3894. The examiner can normally be reached on Monday-Friday from 8 A.M. to 4 P.M.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Michael Woodward, Ph.D., can be reached on (703)308-4028.

Any inquiry of a general nature or relating to the status of this application should be directed to Legal Instrument Examiner, Tina Plunkett, whose telephone number is (703)305-3524 or to the Technical Center receptionist whose telephone number is (703) 308-0196.

June 23, 2003


ARDIN H. MARSCHEL
PRIMARY EXAMINER